

Serial No. 10/054,257

Pre-Appeal Brief Request for Review

UTILITY PATENT

B&D No. TN -2239

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Frederick R. BEAN et al.**

Serial No.: 10/054,257

Examiner: **P. Nguyen**

Filed: **January 22, 2002**

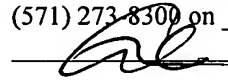
Group Art Unit: **3724**

For: **MITER SAW**

Assistant Commissioner for Patents
Washington, DC 20231

PRE-APPEAL BRIEF REQUEST FOR REVIEW

I, Adan Ayala, PTO Reg. No. 38,373, hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (571) 273-8300 on Nov. 10, 2005



Adan Ayala

Dear Sir:

This is in response to the final Office Action of July 25, 2005. A Notice of Appeal has been filed herewith.

The Examiner rejected Claims 1-7 under 35 USC § 112, first paragraph, for failing to comply with the enablement requirement. In particular, the Examiner has noted that the phrase "said wearing ring not having any movable portions disposed between the table and base assembly." The Examiner asks "how can there be non-movable portions on the wear ring?" As shown in FIG. 2 of the application, the wear ring does not have any moving portions, such as the cylinder bearings 130 of US Patent No. 6,431,042 ("Brault"). Accordingly, the phrase (and claims) have been enabled.

UTILITY PATENT

B&D No. TN -2239

The Examiner rejected Claims 1-7 under 35 USC § 102(e) as being anticipated by US Patent No. 6,431,042 (“Brault”).

Admittedly, Brault has a base assembly, a table rotatably attached to the base assembly, a saw assembly pivotably attached to the table, and a wear ring non-fixedly disposed between the base assembly and the table. However, the wear ring has bearings 130 disposed between the table and base assembly.

By contradistinction, Claim 1 requires that the wear ring not have “any movable portions disposed between the table and base assembly.” Brault’s wear ring has bearings 130, which are movable portions disposed between the table and base assembly. See Brault, col. 3, ln. 65 to col. 4, ln. 2. Therefore, Brault cannot anticipate Claim 1 and its dependent claims.

The Examiner rejected Claim 9-10 under 35 USC § 102(e) as being anticipated by US Patent No. 6,418,830 (“Stumpf”).

Admittedly, Stumpf shows a miter saw comprising a base assembly, a table rotatably attached to the base assembly, a saw assembly pivotably attached to the table, a fixed fence attached to the base assembly, and a sliding fence slidably attached to the fixed fence. However, Stumpf does not show the sliding fence having at least one hole for fixing an end stop fixture thereto.

By contradistinction, Claim 9 calls for “the sliding fence having at least one hole for fixing an end stop fixture thereto.”

The Examiner has noted that sliding fence 132 has a hole 178 for fixing an end stop fixture 68. This is incorrect. Reference numeral “68” refers to a bolt for fixing the location of sliding

UTILITY PATENT

B&D No. TN -2239

fence 132. This bolt cannot be used as an end stop fixture contacting a workpiece, as shown in FIG. 14 of the present application. This is because bolt 68 is enclosed by the fixed and sliding fences and never contacts the workpiece. Because Stumpf does not show a sliding fence “having at least one hole for fixing an end stop fixture thereto,” it cannot render Claims 9-10 unpatentable.

The Examiner has argued that the limitation “end stop fixture” is not defined in the claimed language, and thus Stumpf would anticipate Claim 9-10. Such interpretation of “end stop fixture” is incorrect.

Admittedly, during examination, “the claims must be interpreted as broadly as their terms reasonably allow.” MPEP § 2111.02(I). However, this “means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification.” *Id.* (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). In other words, the words of the claim must be given “the ordinary and customary meanings attributed to them by those of ordinary skill in the art.” MPEP § 2111.02(II).

“End stop fixture” has not been defined in the specification. However, such phrase can be easily understood by a person of ordinary skill in the art. The following are the definitions of “stop” and “fixture” according to the Merriam-Webster’s Online Dictionary (www.m-w.com). (Print-outs of the full definitions were provided in the Response to Office Action faxed on June 1, 2005. According to such definitions, “stop” means “a device for arresting or limiting motion.” “Fixture”

UTILITY PATENT

B&D No. TN -2239

means “a device for supporting work during machining.”¹ Accordingly, a person skilled in the art would understand “stop fixture” to be a device that supports a workpiece and arrests the motion of such workpiece during machining.

Based on such plain meaning, the bolt 68 cannot be the claimed end stop fixture contacting a workpiece because bolt 68 is enclosed by the fixed and sliding fences and never contacts the workpiece. Therefore, Stumpf does not show a sliding fence “having at least one hole for fixing an end stop fixture thereto,” and cannot render Claims 9-10 unpatentable.

The Examiner also rejected Claims 13-16 under 35 USC § 102(b) as being anticipated by US Patent No. 5,778,747 (“Chen”).

Admittedly, Chen shows a chop saw with a base assembly, and a saw assembly pivotably attached to the base assembly, the saw assembly comprising an upper blade guard, a plate rotatably attached to the upper blade guard, a lower blade guard rotatably attached to the plate, and a screw engaging the upper blade guard for fixing the plate.

However, Chen does not show the screw being required to be moved a second distance longer than the first distance in order to pivot the plate, or that the second distance is longer than the distance between the lower blade guard and the upper blade guard. The Examiner has argued that the first distance is the thickness of the first tab, and that it is inherent to “unscrew the screw a distance longer than the first distance to pivot the plate 88.”

¹ Applicants submit that the Examiner’s proposed definition of “fixture” as the “state of being fixed” does not apply to the phrase “end stop fixture.” Otherwise, the phrase would mean the “end stop state of being fixed,” which is non-sensical.

UTILITY PATENT

B&D No. TN -2239

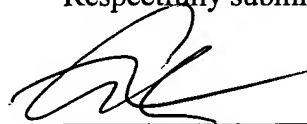
Assuming for the sake of argument that the Examiner's interpretation of Claim 13 and Chen are correct, Chen still does not show all the claimed elements. In particular, Chen does not show or suggest that the second distance is longer than the distance between the lower blade guard and the upper blade guard.

By contradistinction, Claim 13 requires that "the second distance be[ing] longer than [the] distance between the lower blade guard and the upper blade guard." Since Chen is silent as to the distance required for the screw to allow pivoting of the plate, it cannot teach or suggest all the claimed elements. Accordingly, Chen cannot anticipate Claim 13 and its dependent claims.

No fee is believed due. Nonetheless, the Commissioner is authorized to charge payment of any due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

In view of the foregoing, Claims 1-7, 9-10 and 13-16 are patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



Adan Ayala, Reg. No. 38,373
Attorney for Applicants
Phone No. (410) 716-2368